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OFFICE OF PETITIONS

In re Application of :
Marty Williams :
Application Number: 10/711,961 : ON PETITION
Filing Date: 10/15/2004 :
Attorney Docket Number: :
10.18.07.USP :

This is a decision on the petition filed on August 6, 2010, under 37 CFR 1.137(a),¹ to revive the above-identified application.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or as discussed below "Renewed Petition under 37 CFR 1.137(b)."

The application became abandoned on January 17, 2009, for failure to timely submit a reply to the final Office action mailed on October 16, 2008, which set a three (3) month shortened statutory

¹ A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

period for reply. Notice of Abandonment was mailed on May 12, 2009.

On August 6, 2010, a petition under 37 CFR 1.137(b), petition fee under \$1.17(m), and a Request for Continued Examination (RCE), RCE fee, an amendment as the submission under 1.114 were filed. Also on August 6, 2010, a petition under 37 CFR 1.137(a) was filed.

The petition under 37 CFR 1.137(a) states, in part:

Applicant previously submitted a petition under unintentional and paid the revival fees of \$810... After further consideration Applicant filed for revival under the unavoidable standard and filed that petition...

Applicant respectfully requests a refund in the amount of \$540, i.e., the difference between the \$810 paid for unintentional and the \$270 amount due for unavoidable petition.

MPEP 607.02 states, in pertinent part:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment). When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). 37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

The showing of record is that petitioner filed the petition under 37 CFR 1.137(b), and paid the fee due therefor, then decided thereafter to file a petition under 37 CFR 1.137(a) instead. Such action constitutes a change of purpose under 37 CFR 1.26(a)

which does not entitle the party to a refund of such fee. Nevertheless, the petition under 37 CFR 1.137(b) will be held in abeyance, and applicant may pay the difference to request reconsideration under 37 CFR 1.137(b).

Petitioner Marty Williams asserts that prosecution of the application was unavoidably delayed due to the actions or inactions of petitioner's counsel, Glenn Webb (hereinafter "Webb"). Specifically, petitioner states that Webb neglected petitioner's intellectual properties and also recently informed petitioner that he (Webb) was diagnosed with clinical depression, "and that the onset of the disease matches with the accelerating neglect of [petitioner's] intellectual property portfolio."

Petitioner has also provided a statement by Webb, with regard to three issued patents U.S. Patent Nos. 6,042,175, 6,213,539, and 6,398,290, which had expired for non-payment of the maintenance fees. Webb states, in essence, that the maintenance fee in the '175 patent was not paid because petitioner had decided not to maintain that patent. Webb states that the maintenance fees in the patents were not paid in the '539 and '290 patents due to docketing difficulties due to Webb's moving to a new law firm. Webb further states that he became aware of the abandonment of the '539 and '290 patents on June 18, 2008, but that petitioner Williams never instructed Webb to proceed with reinstating the expired patents. Webb further states that petitioner Williams had "decided to discuss the issues with the licensor and would further instruct me at a later time."

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".² Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If

² 35 U.S.C. § 133.

unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).⁵ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(a):

- (1) The delay in reply that originally resulted in expiration;
- (2) The delay in filing an initial petition pursuant to § 1.137(a) to revive the application; and
- (3) The delay in filing a *grantable* petition pursuant to § 1.137(a) to revive the application.⁵

This petition lacks the showing required by periods (1) and (2).

With regards to period (1), above, the statement of unavoidable delay attached to the petition requests reinstatement of expired patents, not the revival of an abandoned application. It appears that petitioner did not prepare a separate statement of unavoidable delay for the subject petition to revive. Further, the statement on Page 3 of the PTO/SB/61 form is not signed and

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵ See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

does not contain an explanation of why the delay was unavoidable, but, rather, merely references documents related to the petitions under 37 CFR 1.378(b) to reinstate the expired patents.

Further, the statement from Webb pertains only to the expired patents, and does not address the abandonment of the subject application.

With regard to petitioner's apparent contention that his former counsel, Webb, failed to communicate with him and timely take action to in this case, petitioner should send a letter to Webb, informing him that the Office is investigating the cause of the delay in responding to the final Office action mailed on October 16, 2008, asking him to respond in writing within one (1) month of the receipt of said letter with an explanation as to why a response to the final Office action mailed on October 16, 2008, was not timely filed. A copy of this decision should be included. Any response received from Webb should be included with a renewed petition. If no response is received, petitioner should so state in any renewed petition.

In any event, while petitioner allegedly chose to rely upon attorney Webb, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 USC 133.⁶ Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether Webb acted reasonably and prudently.⁷ Nevertheless, petitioner is bound by any errors that may have been committed by Webb.⁸

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.⁹ Specifically, petitioner's delay caused by the mistakes or negligence of his or her voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.¹⁰ Furthermore, the U.S. Patent and Trademark Office is not the

⁶ See California Med. Prod. v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

⁷ Id.

⁸ California, *supra*.

⁹ Link v. Wabash, 370 U.S. 626, 633-34 (1962).

¹⁰ Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

proper forum for resolving disputes between applicants and their representatives.¹¹

While physical or mental incapacitation can be a cause of delay, a showing of "unavoidable" delay based upon incapacitation must establish that the attorney's incapacitation was of such a nature and degree as to render the practitioner unable to conduct business (e.g. correspond with the Office) during the period between January 16, 2009, and August 6, 2010. Such a showing must be supported by a statement from the practitioner's treating physician, and such statement must provide the nature of petitioner's incapacitation during the above-mentioned period. Petitioner has not provided a statement from petitioner's treating physician providing the nature and degree of petitioner's incapacitation during the period from when the maintenance fee was due until the filing of the present petition

Simply put, petitioner has provided evidence to support neither his allegations that Webb neglected petitioner's application nor that Webb suffered mental incapacitation. Rather, the attached statement from Webb reflects that there is a dispute between petitioner and his former attorney, Webb. As stated, *supra*, the Office is not the proper forum for resolving disputes between applicants and their representatives.

With regard to period (2), above, it is noted that a revocation of power of attorney with a new power of attorney to Customer No. 35,870 the Customer Number associated with petitioner's current registered patent practitioner, was filed on May 19, 2010. The power of attorney was accepted on May 26, 2010. The subject petition was not filed until August 6, 2010, over two (2) months after the power of attorney was granted, and petitioner would presumably have discovered that the application was abandoned. Petitioner must explain, in any renewed petition, when he discovered that the subject application was abandoned, and show that any delay in filing the petition under 37 CFR 1.137(a) was unavoidable.

In summary, the showing of record suggests that the abandonment resulted from a dispute with petitioner's former counsel rather than as a result of unavoidable delay. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

¹¹ See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

As the showing of record is insufficient to satisfy the requirements of a grantable petition under 37 CFR 1.137(a), the petition will be dismissed.

ALTERNATIVE VENUE

As stated above, the petition under 37 CFR 1.137(b) is held in abeyance pending reconsideration of the petition under 37 CFR 1.137(a). Alternatively, petitioner may again file a petition under 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioners decide to file a petition under 37 CFR 1.137(b), the additional petition fee due is currently \$**540.00** (\$810.00 - \$270.00) for a small entity.¹²

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

¹² As Office fees are revised from time-to-time, petitioner is encouraged to check the USPTO website at www.uspto.gov for current fee amounts prior to submission of any petition. Alternatively, petitioner may contact the Office by phone at 1-800-PTO-9199 for fee information.

A reply may also be filed via the EFS-Web system of the USPTO.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

A handwritten signature in black ink, appearing to read "D. Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions